

REMARKS

Initially, Applicants' attorney notes with appreciation that the Examiner consented to conduct a telephonic interview regarding the present Office Action, said telephonic interview being conducted on December 15, 2004. Applicants' attorney also notes that an RCE has been submitted herewith, to continue the prosecution of the pending application.

Turning to the present Office Action, the Examiner has rejected Claims 1-4, 6-17, 23 and 24 as being anticipated under 35 U.S.C. 102(e) by U.S. Patent 6,333,029 to Vyakarnam et al. ("the Vyakarnam Patent"). Applicants respectfully traverse this rejection. The tissue scaffolding of independent Claim 1 has a porous ceramic phase and a porous polymer phase attached to the ceramic phase at an interphase zone (i.e., a zone where the polymer phase infiltrates the pores of the ceramic phase). Independent Claim 1 has been amended to clearly establish that the scaffold has at least two phases and a means (i.e., the interphase zone) for providing attachment of two of the phases to each other. Claim 1 has also been amended to include the Markush groupings of Claims 14 and 15, combined into a single Markush group. Method Claims 23 and 24 recite methods for producing composite scaffolds having a porous polymer phase, formed by foaming a polymer solution, which interlocks with a porous ceramic body where the polymer solution has infused into the ceramic body.

The Examiner correctly states that the Vyakarnam Patent discloses a polymer phase that is porous and is a foam, and that the Vyakarnam Patent does not

exclude structures in which the polymer interacts with a ceramic structure. However, it is well-established in patent law that, in order to anticipate a claim, a prior art reference must disclose each and every element of that claim. The Vyakarnam Patent does not disclose any interaction between a polymer phase and a ceramic phase, much less an interphase zone, therefore the Vyakarnam Patent does not anticipate Claim 1. With regard to method Claims 23 and 24, the Examiner correctly states that the Vyakarnam Patent teaches a lyophilization process. However, the Vyakarnam Patent does not teach a process for lyophilizing a polymer so that it interlocks with a ceramic body.

Applicant's attorney notes with appreciation the Examiner's suggestion, made during the aforementioned telephone conference, that a Statement of Common Ownership might be used to remove the Vyakarnam Patent as a reference under the § 102(e) rejection. The Applicants respectfully decline to assert the common ownership of the reference and application in the context of the § 102(e) rejection. Section 706.02(l)(3) of the MPEP indicates that common ownership removes a reference that qualifies as prior art under § 102(e) only when such reference is asserted in a § 103(a) rejection. As discussed below, Applicants do assert common ownership as a basis for removing the Vyakarnam reference in the context of the Examiner's claim rejections made under § 103(a).

Turning the to § 103(a) rejections, the Examiner has rejected Claims 1-4 and 6-22 as being obvious over U.S Patent No. 5,084,051 to Tormälä et al. ("the Tormälä Patent") in view of the Vyakarnam Patent. The Examiner states that filing a Statement of Common Ownership of the present application and the Vyakarnam Patent would be effective to overcome a § 103(a) rejection, since the Vyakarnam Patent

constitutes prior art only under § 102(e). Applicants' attorney filed such a Statement of Common Ownership on July 12, 2004. A copy of the Statement was printed from the Image File Wrapper for the pending Application and is attached hereto. The date stamp in the upper left corner of the Statement shows that the Statement was logged in at the USPTO on July 15, 2004. Thus, Applicants respectfully urge that the obviousness rejection of Claims 1-4 and 6-22 be withdrawn.

The Examiner has also rejected Claims 18-22 and 25-28 under 35 U.S.C. 103(a) over the Vyakarnam Patent. Applicants submit that the Statement of Common Ownership discussed above is sufficient to overcome the rejection of these claims, as discussed in the preceding paragraph, and respectfully urge that the obviousness rejection of Claims 18-22 and 25-28 be withdrawn.

It is believed that a fee of \$450 is due for the two-month extension of the period for response to the Office Action, and that a separate fee of \$790 is due for the RCE submitted herewith. The Examiner is hereby authorized to charge these fees to Deposit Account No. 501402. If any additional fees are due, including extension and petition fees, the Examiner is hereby authorized to charge such fees to Deposit Account No. 501402.

Respectfully Submitted,



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